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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,254	02/08/2002	Jacques Sebban	05725.1001	1052
22852	7590	11/16/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/980,254

Applicant(s)

SEBBAN, JACQUES

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The corrected drawings were received on 18 August 2004. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-19, 25, 28-31, 33, 34, 41, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuhara (5,078,159; cited by Applicant).

Yuhara discloses a make-up compact comprising a base 10, an intermediate element 30, and a lid 20 (see Figs. 3a-3d). The base comprises a compartment defined in a receptacle 12 for make-up 11 (see col. 3, lines 37-38). The base has a rear lateral wall delimited by a first edge adjacent the lid (when closed) and a second edge, opposite the first edge. The base includes a first catch member 16 on the lateral wall, a small distance from the first edge, and an opening 43 extending in a plane at the upper extent of the opening (see Figs. 2 and 3a). The intermediate element includes a second catch member--the portion of the intermediate element that extends into the opening 37 to form a catch surface in the opening to engage the first catch member. The catch members snap together such that the base is irreversibly locked to the intermediate element under normal conditions, yet is reversibly locked when a "slightly strong force"

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is applied (see col. 5, lines 31-36 and col. 5, line 63 - col. 6, line 6). Either or both of the catch members must flex in order for the larger surface of the first catch member 16 to pass through the smaller opening 37 of the second catch member (see Figs 3b and 3c). The intermediate element pivots relative to the lid and the base, and the lid pivots 360 degrees relative to the base (see Figs. 3a-3d). When the first and second catch members engage to lock the intermediate element to the base, both the base and the intermediate element are arranged on one side of the plane (see Fig. 3b). The intermediate element includes a first longitudinal edge (the edge to which the assembly line appears to point in Fig. 5, i.e., the upper edge facing the compact, when the lid is closed), a second longitudinal edge opposite the first longitudinal edge (i.e. the less obtuse vertex beneath the first edge, when the lid is closed), a first articulation axis 36 in the vicinity of the first edge, and a second articulation axis 38 in the vicinity of the second edge (see Figs. 3b and 5). The articulation axes comprise pin hinges 31, 32 (see Fig. 2). A latch 23,14 reversibly locks the lid to the base in a closed position (see Figs. 3a and 3b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuhara (5,078,159; cited by Applicant).

Yuhara discloses the claimed invention except for the lid being formed from a material chosen from urea formaldehyde, acrylobutadiene styrene, polyoxymethylene, and polystyrene acrylonitrile. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the lid from urea formaldehyde, acrylobutadiene styrene, polyoxymethylene, and polystyrene acrylonitrile, or from any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It also would have been obvious to substitute a catch member having a hook shape for a catch member having snap configuration since this amounts to nothing more than the substitution of functionally equivalent latching mechanisms known in the art.

Claims 20-24, 26, 35-40, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuhara (5,078,159; cited by Applicant) in view of Lunderman et al. (4,840,288; cited by Applicant).

Yuhara discloses the claimed invention except for the case being molded in a single piece and including one or more film hinges. Lunderman et al. disclose that single-piece molded cases with film hinges and cases with pin hinges are functionally equivalent cases and hinge types known in the art (see col. 3, lines 7-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a case molded in a single piece and including film hinges for a

case with pin hinges, as this is merely the substitution of functionally equivalent cases and hinge types known in the art. It would have been further obvious to form the case from a polyolefin or polypropylene polyolefin, or from any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

Applicant's arguments filed 18 August 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Yuhara does not anticipate applicant's invention because it allegedly does not disclose irreversible means for catching, it is noted that applicant's specification must clearly set forth the definition of "irreversible" explicitly and with reasonable clarity, deliberateness, and precision. Exemplification is not an explicit definition. Even explicit definitions can be subject to varying interpretations. See *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01. It is noted that the catching means 16,37 of Yuhara are well within at least a broadest reasonable interpretation of "irreversible," since under normal conditions, the base 10 and the intermediate element 30 are not separated. Yuhara discloses what is meant by "normal" conditions of use (see Yuhara, col. 5, line 63 - col. 6, line 6, which was cited by the examiner in the Office Action at page 3, line 7).

Normal conditions of use refers to when the lid is opened to expose the product and then closed. The only time when the catching means are not retained together is before the device is ever even used and is still in its packaging and on display for sale (as best seen in Fig. 4, also see col. 5, lines 43-53). Therefore, it is reasonable to consider the means for catching to be irreversible since they are prevented from being separated in their normal state of use. In contrast, it is noted that the engagement between members 14 and 23 (i.e. the latch at the front of the compact) is reversible since the latch is opened and closed repeatedly, perhaps several times a day over the life of the product. Thus, in determining whether the catching means can be considered irreversible, at least within a broadest reasonable interpretation, it must be considered whether the catching means are even separated at all in their normal use, which of course, in the case of Yuhara, they are not. Likewise, with regard to the latch 14,23 at the front of the device, the high frequency with which it is separated, must be given weight, since this indicates that it is correctly considered to be reversible.

In response to applicant's argument that Lunderman et al. do not render applicant's invention obvious, it is noted that Lunderman et al., show that pivot hinges and film (a.k.a., live or living) hinges were equivalent hinge structures for cosmetic compacts, known in the art (see col. 3, lines 7-16). Where evidence shows that two elements were known equivalents in a given art, this constitutes strong evidence of obviousness of substituting one for the other. *Smith v. Hayashi*, 209 USPQ 759 (Bd. of Pat. Inter. 1980). Moreover, an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious.

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*In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Furthermore, in response to applicant's argument that there would not be a reasonable expectation of success in providing the "complex structural configuration" (i.e., pivot hinges) of Yuhara as film hinges (applicant's arguments, page 13, lines 1-4), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It would be difficult to conceive of a person of ordinary skill in the art of cosmetic compacts at the time of applicant's invention who could not readily appreciate that pivot hinges and film hinges can be substituted for each other, and that the details of doing the same would involve nothing more than obvious and routine design choice. This is especially so given the prior disclosure in Lunderman et al. It is also noted that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, of course, the knowledge of using either film or pivot hinges for cosmetic compacts was clearly known, as evidenced by Lunderman et al. One would have had no reason to resort to applicant's disclosure for



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this knowledge since it had already been known in the art at least since 1989 when Lunderman et al. was published.

***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
10 November 2004



EDUARDO C. ROBERT  
PRIMARY EXAMINER